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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,992	08/28/2001	Avi J. Ashkenazi	P2730P1C1	8312

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KEMMERER, ELIZABETH

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1646

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/941,992	ASHKENAZI ET AL.
	Examiner Elizabeth C. Kemmerer, Ph.D.	Art Unit 1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 July 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 119-131 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 119-131 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Status of Application, Amendments, And/Or Claims***

The amendment filed 26 November 2001 (Paper No. 5) has been entered in full.

Claims 1-118 are canceled. Claims 119-131 are under examination.

### ***Specification***

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Also, pp. 303-306 of the specification are missing.

### ***35 U.S.C. §§ 101 and 112, First Paragraph***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 119-131 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility.

The claims are directed to isolated polypeptides having at least 80% identity to a

SEQ ID NO: 20 with or without its signal peptide, or to the extracellular domain of SEQ ID NO: 20 with or without its signal peptide. Dependent claims are directed to vectors and host cells comprising the isolated nucleic acids. Finally, claims are presented to chimeric proteins comprising the aforementioned polypeptides. The specification contains numerous asserted utilities including use as hybridization probes, in chromosome and gene mapping, in the generation of anti-sense RNA and DNA, to identify molecules that bind to PRO (including agonists and antagonists), to make "knock-out" mice or other animals, in gene therapy, as molecular weight markers, therapeutic agents, and for the production of antibodies. The utilities that pertain solely to nucleic acids (e.g. hybridization, chromosome and gene mapping, anti-sense) would not convey to the encoded protein. With respect to the remaining utilities, none of these asserted utilities is specific for the disclosed PRO341 protein, as each of the aforementioned utilities could be asserted for any naturally occurring protein, and further, as none of the asserted utilities requires any feature or activity that is specific to the disclosed PRO341.

The specification teaches that PRO341 is a membrane-bound polypeptide with several transmembrane domains. The specification does not disclose that PRO341 has significant structural similarity to any fully characterized polypeptides. There is no biological activity, expression pattern, phenotype, disease or condition, ligand, binding partner, or any other specific feature that is disclosed as being associated with PRO341. Without any information as to the specific properties of PRO341, the mere identification of such as being a membrane-bound polypeptide possessing several

transmembrane domains is not sufficient to impart any particular utility to the claimed polypeptides.

At pages 539-555, it is disclosed that nucleic acids encoding PRO341 had a  $\Delta Ct$  value of at least 1.0 for a number of primary lung tumors, but not for all tested colon or lung tumor cell lines. At page 548,  $\Delta Ct$  is defined as the threshold PCR cycle, or the cycle at which the reporter signal accumulates above the background level of fluorescence. The specification further indicates that  $\Delta Ct$  is used as "a quantitative measurement of the relative number of starting copies of a particular target sequence in a nucleic acid sample when comparing cancer DNA results to normal human DNA results." The Examiner is unable to find, either in the specification or in the art, an explanation of how  $\Delta Ct$  values are calculated, nor what the significance of such are. It is noted that at page 548, it is stated that samples are used if their values are within 1  $Ct$  of the 'normal standard'. It is further noted that the  $\Delta Ct$  values at pages 550-554 are expressed (a) with values to one one-hundredth of a unit (e.g. 2.58), and (b) that very few values were obtained that were at least 2. It is not clear how measurements of hundredths of a PCR cycle can be made, nor what the significance of a difference of 1 or 2 PCR cycles would be. Given the paucity of information, the data do not support the implicit conclusion of the specification that PRO341 shows a positive correlation with lung cancer, much less that the levels of PRO341 would be diagnostic of such. Even *if* the data demonstrated a slight increase in copy number of PRO341 nucleic acids in primary tumors, such would not be indicative of a use of the encoded polypeptide as a diagnostic agent. Cancerous tissue is known to be aneuploid, that is, having an

abnormal number of chromosomes (see Sen, 2000, Curr. Opin. Oncol. 12:82-88). The data presented in the specification were not corrected for aneuploidy. A slight amplification of a gene does not necessarily mean overexpression in a cancer tissue, but can merely be an indication that the cancer tissue is aneuploid. The preliminary data were not supported by analysis of mRNA or protein expression, for example. Also, the literature reports that it does not necessarily follow that an increase in gene copy number results in increased gene expression and increased polypeptide expression, such that the claimed polypeptides would be useful for diagnosis of cancer or as a drug target. For example, Pennica et al. (1998, PNAS USA 95:14717-14722) disclose that:

“An analysis of *WISP-1* gene amplification and expression in human colon tumors showed a correlation between DNA amplification and overexpression, whereas overexpression of *WISP-3* RNA was seen in the absence of DNA amplification. In contrast, *WISP-2* DNA was amplified in the colon tumors, but its mRNA expression was significantly reduced in the majority of tumors compared with the expression in normal colonic mucosa from the same patient.”

See p. 14722, second paragraph of left column; pp. 14720-14721, “Amplification and Aberrant Expression of *WISPs* in Human Colon Tumors.” Therefore, data pertaining to PRO341 nucleic acids do not necessarily indicate anything significant regarding the claimed PRO341 polypeptides. Thus, the data do not support the implicit assertion that PRO341 can be used as a cancer diagnostic. Significant further research would have been required of the skilled artisan to determine whether PRO341 is overexpressed in any cancer to the extent that it could be used as a cancer diagnostic, and thus the implicitly asserted utility is not substantial.

Claims 119-131 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Furthermore, the specification does not enable the claimed variants of SEQ ID NO: 20. The problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. While it is known that many amino acid substitutions are generally possible in any given protein the positions within the protein's sequence where such amino acid substitutions can be made with a reasonable expectation of success are limited. Certain positions in the sequence are critical to the protein's structure/function relationship, e.g. such as various sites or regions directly involved in binding, activity and in providing the correct three-dimensional spatial orientation of binding and active sites. These or other regions may also be critical determinants of antigenicity. These regions can tolerate only relatively conservative substitutions or no substitutions (see Wells, 1990, Biochemistry 29:8509-8517; Ngo et al., 1994, The Protein Folding Problem and Tertiary Structure Prediction, pp. 492-495). However, Applicant has provided little or no guidance beyond the mere presentation of sequence data to enable one of ordinary skill in the art to determine, without undue experimentation, the positions in the protein which are tolerant to change (e.g. such as by amino acid substitutions or deletions), and the nature and extent of changes that can be made in these positions. Although the specification outlines art-recognized

Art Unit: 1646

procedures for producing and screening for active muteins, this is not adequate guidance as to the nature of active derivatives that may be constructed, but is merely an invitation to the artisan to use the current invention as a starting point for further experimentation. Even if an active or binding site were identified in the specification, they may not be sufficient, as the ordinary artisan would immediately recognize that an active or binding site must assume the proper three-dimensional configuration to be active, which conformation is dependent upon surrounding residues; therefore substitution of non-essential residues can often destroy activity. The art recognizes that function cannot be predicted from structure alone (Bork, 2000, Genome Research 10:398-400; Skolnick et al., 2000, Trends in Biotech. 18(1):34-39, especially p. 36 at Box 2; Doerks et al., 1998, Trends in Genetics 14:248-250; Smith et al., 1997, Nature Biotechnology 15:1222-1223; Brenner, 1999, Trends in Genetics 15:132-133; Bork et al., 1996, Trends in Genetics 12:425-427). Due to the large quantity of experimentation necessary to generate the infinite number of derivatives recited in the claims and possibly screen same for activity, the lack of direction/guidance presented in the specification regarding which structural features are required in order to provide activity, the absence of working examples directed to same, the complex nature of the invention, the state of the prior art which establishes the unpredictability of the effects of mutation on protein structure and function, and the breadth of the claims which fail to recite any structural or functional limitations, undue experimentation would be required of the skilled artisan to make and/or use the claimed invention in its full scope.

Finally, claims 119-124 and 129-131 encompass polypeptides that are structurally defined by reference to a biological deposit, ATCC accession number 209792. Since the deposited molecules are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise readily available to the public. If the deposited molecules are not so obtainable or available, the requirements of 35 U.S.C. § 112 may be satisfied by a deposit of the nucleic acid molecules. The specification does not disclose a repeatable process to obtain the deposited molecules and it is not apparent if the deposited molecules are readily available to the public. It is noted that Applicant has made a deposit (pp 563-565 of the specification), but there is no indication in the specification as to public availability. If the deposit is made under the Budapest Treaty, then an affidavit or declaration by Applicant, or a statement by an attorney of record over his or her signature and registration number, stating that the specific nucleic acid molecules have been deposited under the Budapest Treaty and that the nucleic acid molecules will be irrevocably and without restriction or condition released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein. If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. §§ 1.801-1.809, Applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that:

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;
- (d) a test of the viability of the biological material at the time of deposit will be made (see 37 C.F.R. § 1.807); and
- (e) the deposit will be replaced if it should ever become inviable.

Claims 119-131 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to polypeptides having at least 80%, 85%, 90%, 95% or 99% sequence identity with a particular disclosed sequence. The claims do not require that the polypeptide possess any particular biological activity, nor any particular conserved structure, or other disclosed distinguishing feature. Thus, the claims are drawn to a genus of polypeptides that is defined only by sequence identity. Further, the claims require the 'extracellular domain' of the protein, for which there is no description in the specification.

To provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is a partial structure in the form of a recitation of percent identity. There is not even identification of any particular portion of the structure that must be conserved. Accordingly, in the absence of sufficient recitation of distinguishing

identifying characteristics, the specification does not provide adequate written description of the claimed genus.

*Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” (See page 1117.) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF’s were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only isolated polypeptides comprising the amino acid sequence set forth in SEQ ID NO: 20, with or without the signal sequence, but not the full breadth of the claims meet the written description provision of 35 U.S.C. §112, first paragraph.

Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

***35 U.S.C. § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 119-124 and 129-131 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The protein identified as PRO341 is disclosed as having several transmembrane domains. The claims recite “the extracellular domain”. However, if there are several transmembrane domains, then there must be several extracellular domains. It is unclear which extracellular domain is intended. Further, the recitation of “the extracellular domain”...“lacking its associated signal sequence” (claim 22, part (d), for example) is indefinite as a signal sequence is not generally considered to be part of an extracellular domain, as signal sequences are cleaved from said domains in the process of secretion from the cell.

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D., whose telephone

Art Unit: 1646

number is (703) 308-2673. The examiner can normally be reached on Mondays through Thursdays from 6:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



ELIZABETH KEMMERER  
PRIMARY EXAMINER